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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES

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8 *Ex parte* DANIEL LEE BRILEY

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11 Appeal 2009-005646
12 Application 10/086,311
13 Technology Center 3600

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16 Decided: March 12, 2010

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19 Before HUBERT C. LORIN, ANTON W. FETTING, and BIBHU R.
20 MOHANTY, *Administrative Patent Judges*.
21 FETTING, *Administrative Patent Judge*.

22 DECISION ON APPEAL

23

1 STATEMENT OF THE CASE

2 Daniel Lee Briley (Appellant) seeks review under 35 U.S.C. § 134
3 (2002) of a final rejection of claims 1, 4-11, and 14-20, the only claims
4 pending in the application on appeal.

5 We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b)
6 (2002).

7 SUMMARY OF DECISION¹

8 We AFFIRM.

9 THE INVENTION

10 The Appellant invented a mail and postage system, including non-visible
11 marks in postage evidence of a mail piece (Specification 1:5-6).

12 An understanding of the invention can be derived from a reading of
13 exemplary claims 1 and 11, which are reproduced below [bracketed matter
14 and some paragraphing added].

15 1. A mail system configured to process postage evidence on a
16 mail piece, the mail system comprising:

17 [1] a handling system configured to receive the mail piece,
18 scan the postage evidence for visible marks and non-visible
19 marks to read visible mark information indicated by the visible
20 marks and non-visible mark information indicated by the non-

¹ Our decision will make reference to the Appellant's Appeal Brief ("App. Br.," filed July 7, 2008) and Reply Brief ("Reply Br.," filed November 4, 2008), and the Examiner's Answer ("Ans.," mailed September 4, 2008), and Final Rejection ("Final Rej.," mailed February 4, 2008).

1 visible marks, and transfer the visible mark information and the
2 non-visible mark information; and

3 [2] a processing system coupled to the handling system and
4 configured to process the visible mark information and the non-
5 visible mark information to generate postage information for
6 the mail piece;

7 [3] wherein the handling system is further configured to scan
8 the non-visible marks using an Ultra Violet (UV) or an Infrared
9 (IR) light, and to process information in the non-visible marks
10 to validate information in the visible marks; and

11 [4] wherein the non-visible marks are also detectable by
12 human eye using a UV light for human confirmation of the non-
13 visible marks.

14

15 11. A method for processing postage evidence on a mail piece,
16 the method comprising:

17 [1] receiving the mail piece;

18 [2] scanning the postage evidence for visible marks and non-
19 visible marks to read visible mark information indicated by the
20 visible marks and non-visible mark information indicated by
21 the non-visible marks, wherein the non-visible marks are
22 scanned using an Ultra Violet (UV) or an Infrared (IR) light,
23 and wherein the non-visible marks are also detectable by human
24 eye using a UV light for human confirmation of the non-visible
25 marks; and

26 [3] processing the visible mark information and the non-
27 visible mark information to generate postage information for
28 the mail piece.

29

30 THE REJECTIONS

31 The Examiner relies upon the following prior art:

Leon US 6,701,304 B2 Mar. 2, 2004

32

Appeal 2009-005646
Application 10/086,311

1 Claims 1, 4-11, and 14-20 stand rejected under 35 U.S.C. § 103(a) as
2 unpatentable over Leon.

ISSUE

The issue pertinent to this appeal is whether the Examiner erred in rejecting claims 1, 4-11, and 14-20 under 35 U.S.C. § 103(a) as unpatentable over Leon. This pertinent issue turns on whether Leon describes, “generat[ing] postage information for the mail piece”, as required by limitation [2] of claim 1.

FACTS PERTINENT TO THE ISSUES

10 The following enumerated Findings of Fact (FF) are believed to be
11 supported by a preponderance of the evidence.

Facts Related to the Prior Art

Leon

1 to account for the requested indicium value and generates the user
2 requested indicium (Leon 7:35-37). The generated indicium is
3 further printed by either a host computer or under the direction of
4 the SMD 1 on to a postage label (Leon 7:41-53).

5 03. The human-readable portion of the indicium includes texts and
6 graphics, such as date, address, and postage amount, and can be
7 interpreted by an operator or auditor without the use of special
8 translation equipment (Leon 8:7-10). The machine-readable
9 portion includes graphical representations and encoded texts, such
10 as bar codes, FIM marks, data matrix, encoded texts, specifically
11 formatted texts, and unintelligible texts that are not readily
12 interpreted by an operator or auditor (Leon 8:10-15). The postage
13 labels further include identifier information that exhibits special
14 characteristics that can be used for authenticating the indicia
15 (Leon 8:15-18). The indicia includes various data fields, with
16 each field including any combination of elements, where an
17 element included in the bar code data can also be included in the
18 human-readable data (Leon 11:22-28 and Table 1). For example,
19 postage and date of mailing are included in both the bar code data
20 and the human-readable data, whereas the digital signature and
21 licensing zip code are only included in the bar code data (Leon
22 Table1).

23 04. Elements of the indicia can be printed using various types of
24 ink, including visible and invisible inks and fluorescent and non-
25 fluorescent inks (Leon 9:14-16). The invisible ink may become

apparent to the human eye under light of a specified wavelength, such as UV light (Leon 9:18-20).

3 05. Leon further describe an authentication system used to
4 authenticate indicia (Leon 13:18-20). The printed indicium label
5 is provided to an authentication system where a data reader reads
6 the human-readable portion, a symbology reader reads the
7 machine-readable portion, and a marking detector reads other
8 prints (Leon 13:21-27). The detected information is passed to a
9 computer that analyzes, verifies, and authenticates the information
10 (Leon 13:34-35).

PRINCIPLES OF LAW

Obviousness

13 A claimed invention is unpatentable if the differences between it and
14 the prior art are “such that the subject matter as a whole would have been
15 obvious at the time the invention was made to a person having ordinary skill
16 in the art.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007); *Graham*
17 *v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

In *Graham*, the Court held that that the obviousness analysis is bottomed on several basic factual inquiries: “[1] the scope and content of the prior art are to be determined; [2] differences between the prior art and the claims at issue are to be ascertained; and [3] the level of ordinary skill in the pertinent art resolved.” *Graham*, 383 U.S. at 17. See also, *KSR*, 550 U.S. at 406. “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR*, 550 U.S. at 416.

1 ANALYSIS

2 *Claims 1, 4-11, and 14-20 rejected under 35 U.S.C. § 103(a) as*
3 *unpatentable over Leon*

4 The Appellant first contends that Leon fails to describe “generat[ing]
5 postage information for the mail piece”, as required by limitation [2] of
6 claim 1 (App. Br. 5-10 and Reply Br. 5-9). The Appellant specifically
7 argues that the recited “configured to” language is a structural limitation and
8 therefore should be given patentable weight (App. Br. 6-9).

9 We disagree with the Appellant. In constructing the structural
10 limitations of the recited system, we must first evaluate the Appellant’s
11 argument that the “configured to” language imparts a structural limitation
12 and therefore should be given patentable weight (App. Br. 6-9). Limitation
13 [2] requires a processing system, connected to the handling system, which
14 generates postage information by processing visible and non-visible mark
15 information for mail. Limitation [2] specifically requires the processing
16 system to be “configured to” process these marks. Since this functional
17 limitation is configured and associated to the programming system, it is part
18 of the structure thereby imparting a structural limitation and should be
19 afforded patentable weight.

20 Once the meaning of claim 1 has been construed, we must then
21 determine whether Leon describes claim 1. Leon describes a postage
22 metering and authentication system (FF 01). The postage metering system
23 uses a secured metering device to print a metering indicium on to the label
24 of a mailing piece (FF 02). The indicium can be printed using visible and
25 non-visible inks (FF 04). The indicium consists of a human-readable

1 portion, a machine-readable portion, and an identifying portion (FF 02). The
2 human-readable portion includes texts and graphics, such as date, address,
3 and postage amount, and can be read by an operator (FF 02). The machine-
4 readable portion included encoded texts that require special instruments to
5 read (FF 02). Leon further illustrates a list of possible values that can be
6 included in both the human-readable portion and the machine-readable
7 portion (FF 02). For example, postage and date of mailing are included in
8 both the bar code data and the human-readable data (FF 02).

9 Leon also describes a postage authentication system (FF 05). The
10 authentication system utilizes data readers and symbology readers to detect
11 information printed in the indicium on mailing labels, as described in the
12 generation of the indicium *supra* (FF 05). That is, Leon describes that the
13 authentication system is capable of recognizing or detecting any information
14 that the secure metering device prints on to a mailing label, whether the
15 information is printed using visible or invisible ink. The authentication
16 system further analyzes, verifies, and authenticates this detected information
17 (FF 05).

18 As such, Leon describes a system with a postage metering system and an
19 authentication system; where the postage metering system corresponds to the
20 handling system of the claimed invention and the authentication system
21 corresponds to the handling system of the claimed invention. The postage
22 metering system generates postage information, such as postage and date of
23 mailing information, and the authentication system detects this information.
24 The metering system generates information postage indicium using visible
25 and invisible marks, and the authentication system is capable of detecting
26 visible and invisible marks. Therefore, although we agree with the

1 Appellant that the “configured to” language imparts structural limitations
2 and should be afforded patentable weight, Leon describes a processing
3 system, connected to the handling system, which generates postage
4 information by processing visible and non-visible mark information for a
5 piece of mail. As such the Examiner has established a *prima facie* case of
6 obviousness.

7 The Appellant further argues that (2) the invention in Leon and the
8 claimed invention are distinguished because Leon’s printed information is
9 not encoded in indicia and only machine readable information is encoded
10 (Reply Br. 5-7). The Appellant specifically argues that the security
11 information correlated by the Examiner is not postage information because it
12 only signals an on/off description (Reply Br. 8). We disagree with the
13 Appellant. Limitation [2] does not further narrow the scope of what postage
14 information is limited to be and as such any information that related to
15 postage is considered postage information. Leon describes that different
16 values can be printed as either human-readable values or machine-readable
17 values (FF 02). For example, postage and date of mailing are included in
18 both the bar code data and the human-readable data (FF 02). These values
19 are specific postage information and can be encoded or human-readable. As
20 such, Leon describes postage information in the same context as the claimed
21 invention.

22 The Appellant further contends that (3) Leon fails to describe the same
23 element as argued *supra* for claim 1 and since claim 11 is a method claim
24 the Examiner’s structural arguments are moot (App. Br. 8-10 and Reply Br.
25 9-10). As such the Appellant is arguing that the Examiner has failed to set
26 forth a *prima facie* case of obviousness (App. Br. 9-10 and Reply Br. 9-10).

1 We disagree with the Appellant. As discussed *supra*, although the
2 Appellant's structural arguments were persuasive, Leon described the
3 limitations of claim 1. The Appellant's arguments were not found
4 persuasive *supra* and are not found persuasive here for the same reasons.

5 The Appellant has not sustained the burden of showing that the
6 Examiner erred in rejecting claims 1, 4-11, and 14-20 under 35 U.S.C.
7 § 103(a) as unpatentable over Leon.

8

9 CONCLUSIONS OF LAW

10 The Examiner did not err in rejecting claims 1, 4-11, and 14-20 under 35
11 U.S.C. § 103(a) as unpatentable over Leon.

12

13 DECISION

14 To summarize, our decision is as follows.

15 • The rejection of claims 1, 4-11, and 14-20 under 35 U.S.C. § 103(a) as
16 unpatentable over Leon is sustained.

17

18 No time period for taking any subsequent action in connection with this
19 appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

20

21 AFFIRMED

22

23

Appeal 2009-005646
Application 10/086,311

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